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| 10/840,198 | 05/05/2004 | Dean A. Klein | MTIPAT.73D4C1 | 7235 |
| 20995 | 7590 | 06/21/2005 | EXAMINER | |
| KNOBBE MARTENS OLSON & BEAR LLP | | | DINH, SON T | |
| 2040 MAIN STREET | | | ART UNIT | |
| FOURTEENTH FLOOR | | | PAPER NUMBER | |
| IRVINE, CA 92614 | | | 2824 | |

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/840,198

Applicant(s)

KLEIN, DEAN A.

Examiner

Son T. Dinh

Art Unit

2824

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 30-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 30-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 May 2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The amendment filed on 4/25/05 has been entered.

Claims 10-29 have been canceled.

Claims 30-40 have been added.

Claims 1-9 and 30-40 are pending in the application.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No.

6,888,734 in view of Klein (U.S. Patent No 6,349,051). Claims 1 –6 of the U.S.

Patent No. 6,888,734 disclose and electronic device comprising a memory controller, a memory circuit, a data bus, a switch (or decoupling means) for controlling the parasitic capacitance on a bus. The only difference between claims 1-9 of the instant application and claims 1-6 of the U.S. Patent No

6,888,734 is that claims 1-6 of the U.S. Patent No 6,888,734 fail to disclose a state decoder for controlling the switch.

Claim 1 of Klein (U. S. Patent No 6,349,051) discloses a state decoder connected to a switch for controlling the operation of the switch. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify claims 1-6 of the U.S. Patent NO 6,888,734 by incorporating a state decoder that connects to a switch for controlling the operation of the switch as taught by claim 1 of Klein (U. S. Patent No 6,349,051).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 and 30-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiggers (U.S. Patent No 6,011,710) in view of Konishi et al (U.S. Patent No 5,815,462).

With respect to claim 1, 4 and 7, figure 4 of Wiggers discloses an electronic device comprising a memory controller (21A), a memory circuit (22A), a data bus (the lines between 33 and 34) coupling the memory controller 21A and the memory circuit 22A, and a switch (29A) for decoupling the data bus (the lines between 33 and 34) from the memory circuit 22A when no memory access is

being requested. It is noted that the isolation of data bus from the memory circuit when no access is requested would reduce the capacitance on the bus i.e. improves the speed of the memory device (see column 2, lines 25-35 and column 5, lines 51-66).

With respect to claims 2, 5 and 8, element 29A (figure 4) is a decoupling means, and there a plurality of element 29A (a plurality of decoupling means) are shown in the circuit of Wiggers.

With respect to claims 3, 6 and 9, the memory circuit of Wiggers is clearly a synchronous DRAM (see column 4, lines 31-33).

With respect to claims 30, 34, the switch of Wiggres is clearly a transfer gate (a transfer would be defined as any device that could transfer data and have an On/Off state).

The only difference between Wiggers and claims 1-9 and 30-40 is that Wiggers fail to teach a state decoder connected to a switch of controlling the operation of the switch. Konishi et al (U.S. Patent No 5,815,462) disclose a memory device having a state decoder (123, figure 26) connected to a switch (136a, the register would be considered as a switch because it has an On/Off state). It is also noted that the address A0-A11 are address signals and could be either considered as row or column address (ca claimed in claims 33, 37 and 40), and the state decoder 123 decodes the address signal from address input 124 as shown in figure 26. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wiggers

by using a state decoder connected to a switch so as to control the operation of the switch as evidenced by Konishi et al.

Response to Arguments

Applicant's arguments with respect to claims 1-9 and 30-40 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son T. Dinh whose telephone number is 571-272-1868. The examiner can normally be reached on Monday to Friday 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Elms can be reached on 571-272-1869. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S. Dinh
June 20, 2005



Son T. Dinh
Primary Examiner